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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,315	07/09/1999	MARTIN ZILLIACUS	11784.101US0	7885

7590

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EXAMINER

HOTALING, JOHN M

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 04/08/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/350,315

Applicant(s)

ZILLIACUS ET AL.

Examiner

John M Hotaling II

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Request for Continued Examination**

1. The Request for Continued Examination (RCE) filed on 3/21/03 under 37 CFR 1.114 based on parent Application No. 09/350,315 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Double Patenting***

2. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/350,330. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose substantially the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darling WO 93/23125 in view of LaDue US Patent Number 5,999,808 and Angell WO 98/47589.

The rejection of the previous office action is maintained and incorporated herein. For

Art Unit: 3713

the convenience of that applicant's representative the following is a copy of the previous office action. With respect to the amended subject matter please see below where it is highlighted that that the services can be adapted and fully integrated with all mobile switching center switching and processing schemes manufactured and operating in the world today. Any one who has used a phone or a cell phone understands call waiting or that and three way calling. It is inherent in the use of a phone to receive a call while playing a game or making another call.

Darling discloses a computer game system allowing interactive, wireless multiplayer game play which comprises a portable computer game machine, memory device and a communications unit. Darling discloses all of the instant application with respect to the game units connection to each other and the game setup (claims 14, 16, 29, 41). Additionally, communication between the units and the game server for game play data is disclosed in Darling. The communications system and protocols allow for interactive or standalone game play to occur between players and also allow games to be updated to include features and/or options. Page 3 disclose that computer game systems, machines and memory devices according to the invention have the advantage that they enable two or more players to participate in the same game without the need for wired interconnections, which are inconvenient and cumbersome. Page 7 discloses that in a preferred embodiment, communications unit 30 is radio frequency based (rf) and provides a substantial range of freedom of movement of one game machine 10 with respect to another and that in some circumstances ~~other communications means may~~ be advantageously employed. Page 8 discloses that transmitter and receiver unit 32

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Art Unit: 3713

can be constructed either from available transmitter and receiver modules or can be custom built. Page 9 discloses that each machine in the group must receive data, in turn, from each other machine in the group and transmit data to all the other machines in the group. Page 20-21 discloses that provided a standard communications protocol is employed, the present invention may be implemented to allow interactive game playing between hand-held game machines manufactured by different companies. Darling discloses the set up of the games and the polling of the wireless game unit for other wireless game units (claims 13, 14, 27, 40, 41). Darling lacks in disclosing using his system on a plurality of mobile phones and identification of each of the phones to be used for playing purposes and specific networks. In an analogous invention LaDue discloses the use of mobile phone technology to play games. LaDue discloses in columns 1 and 2 a wireless gaming method that seamlessly transmits application specific messages over cellular radio control channels and switches for use in wireless gaming and wagering. The disclosed application for LaDue's communications platform is wireless gaming over cellular, paging and signaling networks and discloses that a combination of communications platforms may be used. **Column 3 discloses that the services can be adapted and fully integrated with all mobile switching center switching and processing schemes manufactured and operating in the world today. This wireless gaming system operates in normal cellular, paging, and signaling networks.** Column 4 discloses the control and access to the network, that the present invention provides for full duplex communications by fully integrating cellular transceivers and paging receivers that communicate together within specially designed

Many  
Networks

Art Unit: 3713

and programmed end user CCAD communications terminals. Column 5 discloses a combination of cellular and paging networks. Column 10 discloses that the game caddy can operate on a dual mode cellular transceiver with both digital and analog platforms and another configuration is to establish an in building personal communication network that is compatible but yet distinct from the cellular and paging networks heretofore mentioned and that there are many ways to configure the unique gaming system. Column 20 discloses that the system can communicate with the World Wide Web via the Internet and can access e-mail, WWW file transfer point databases and other network entities and can send and receive e-mail in real time. With respect to claims 9, 10, 23, 24, 36 and 37 that in order to reach a network one must first go through a base station is inherent in the use of a wireless system. With respect to claim 15 Figure 9B shows a mobile phone for use with the gaming system. In yet another analogous invention Angell discloses a wireless interactive gaming system which includes an identification code, a wager entry apparatus, and communications means connected to a central processor establishes and stores a players account corresponding to the identification code and deducts the wager amount from the players account based on the identification code. Page 2 discloses that the wireless transmission may be by radio frequency signals or infrared signals. Page 3 discloses that the identification code may be stored in the memory in a digital format. Page 4 discloses that a large number of players may be able to interact with the same game. With respect to the claim limitations relative to a low power RF link, a low power RF link fits in the category of a normal cellular, paging, and signaling network. One of ordinary skill in the art with

Art Unit: 3713

respect to communication system would recognize and have a tacit understanding that it is inherent in the use of a communication device to have a specific address or identification associated with the device otherwise it would be impossible to have a portable phone. Therefore the claim limitations regarding the identification of the unit as a low power RF link telephone number has been considered but are not considered to patentably distinguish the invention as taught above. With respect to claims 4-8, 18-22, 31-35 where network includes a wide area network, the internet, public land mobile network, public switched telephone network, wireless network please see above where it is disclosed in Darling that provided a standard communications protocol is employed, the present invention may be implemented to allow interactive game playing between hand-held game machines manufactured by different companies and that in some circumstances other communications means may be advantageously employed. All of the claimed network types use a standard and well documented communications protocol and baring any criticality one network is analogous to any of the other networks and as such has been considered by the prior art as disclosed above. With respect to claims 11, 12, 25, 26, 38, and 39 it is an obvious matter of choice well within the capabilities of one skilled in phones art to pause a game, terminate a game or give the option to do either upon receipt of a phone call since such is notoriously well known with respect to phones. Using the above teachings it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference to provide a multi player game scenario on a plurality of different wireless and/or cell phone gaming network using the **motivation of Darling pages 20-21 discloses that provided a**

Art Unit: 3713

standard communications protocol is employed, the present invention may be implemented to allow interactive game playing between hand-held game machines manufactured by different companies and that in some circumstances other communications means may be advantageously employed and the motivation of LaDue that the wireless gaming system operates in normal cellular, paging, and signaling networks with the teachings of Angell that it is well known to have a player module associated with a player ID which could be a phone number.

#### ***Response to Arguments***

4. Applicant's arguments filed 8/2/00 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*



Art Unit: 3713

*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine has been highlighted above in bold type but will be repeated here for the convenience of the applicant's representative. **The motivation of Darling pages 20-21 discloses that provided a standard communications protocol is employed, the present invention may be implemented to allow interactive game playing between hand-held game machines manufactured by different companies and that in some circumstances other communications means may be advantageously employed and the motivation of LaDue that the wireless gaming system operates in normal cellular, paging, and signaling networks with the teachings of Angell that it is well known to have a player module associated with a player ID which could be a phone number.** Further all three of the references are related to analogous subject of interactive gaming over a communication network.

In response to the applicants arguments that LaDue, Darling and Angell fail to teach a multiplayer system where communication is effected between participant's of a game, or between mobile phones, please read the rejection above.

The applicant's representatives argues that the motivation provided with respect to "standard communication protocol" has not been characterized correctly by the examiner since what darling is referring to is the flag, header, data, check, and end flag shown in darling figure 5. The examiner would point out that Darling states on page 21 that in his system all that is needed to allow inter-system communication is common communication protocol and a game cartridge. Since the game cartridge is no longer necessary because of the advance of available memory one of ordinary skill would

Art Unit: 3713

surmise that all one needed to play a game is a common communication protocol and since the mobile telephone communication protocol is largely an commonly available and taught above by the references the motivation stands. Accordingly the rest of the applicant's arguments are moot.

### **Remarks**

5. It is noted that there was no response to the double patenting rejection presented in the previous final rejection and as such the examiner could have made the action a first action final. For the benefit of the prosecution of this application the examiner made this a non-final rejection and request that the applicant's representative initiate a phone interview to discuss the merits of the case.

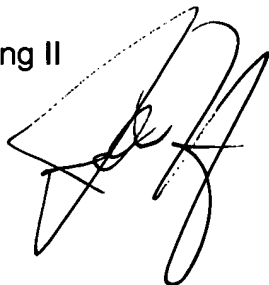
### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 3236 for regular communications and 703 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7777.

John M Hotaling II  
April 4, 2003

A handwritten signature in black ink, appearing to be 'John M Hotaling II', written over a faint, light-colored rectangular stamp or watermark.